

I. U.S. Patent No. 5,963,453 to East is Not Statutory Prior Art

U.S. Patent No. 5,771,657 is accorded a filing date of May 7, 1996. The filing date of U.S. Patent No. 5,963,453 to East is November 24, 1997. The East patent therefore is not statutory prior art for the instant application. Accordingly, and for at least this reason, Applicants respectfully submit that the rejection of claims 1-4, 6-16, 30-31, 36-44, 49-59, 65-76, 81-115 and 121-134 under 35 USC §103(a) over Goldberg in view of East is improper and must be withdrawn.

II. The Rejection Under 35 U.S.C. §103(a) is an Improper Omnibus Rejection

With regard to the rejection of claims 1-4, 6-16, 30-31, 36-44, 49-59, 65-76, 81-115 and 121-134, the Examiner states that Goldberg teaches several elements, which presumably apply to the **claimed** invention, but in no way explains how the elements from Goldberg relate to the **claimed** invention. That is, with regard to Goldberg, there was absolutely no reference to any language of the claims of the instant application, and absolutely no reasoning or explanation as to how the alleged teachings of Goldberg teach any elements of the **claimed** invention.

The Examiner admits that “Goldberg does not specifically disclose the items and transport means as claimed,” and alleges, inter alia, that East “teaches the concept of counting pills,” and “the concept of using a control computer.” The Examiner, however, alleges that “[i]t is well known in the art to use carriers to transport bottles” and “that radio tags are well known in the art,” and concludes from this that “it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Goldberg with transporting and counting means as taught by East to provide for a more synchronized and expedient operation.” Finally, the Examiner states that “Goldberg discloses that items may be packaged,” and that “Goldberg discloses that the system accommodates different size packages, etc.” (pages 2-3 of Office Action).

On this basis, the Examiner rejected claims 1-4, 6-16, 30-31, 36-44, 49-59, 65-76, 81-115 and 121-134. Applicants respectfully submit that the form of the rejection was an omnibus rejection contrary to 37 CFR §1.104(c)(2) and MPEP 707.07(d). The Examiner is respectfully requested to clearly explain the pertinence of each reference as it relates to each element in each rejected claim as required by Rule 104 and to “fully and clearly” state the grounds for rejection

as required by MPEP Section 707.07(d). Nonetheless, Applicants have reviewed the references and traverse the rejections below.

III. Goldberg in View of East Does Not Teach the Claimed Invention

A. Claims 1-3

Goldberg is directed to a different field of endeavor from the claimed invention. Specifically, Goldberg is concerned with loading packages onto a conveyor, and distributing one or more packages associated with an order to an order-assembly lane associated with the order (see, e.g., Abstract; col. 5, lines 36-56). Nothing in Goldberg concerns or relates to dispensing pharmaceuticals. In contrast, independent claim 1, for example, is directed to “[a]n automatic prescription filling and packing system.”

East discloses a system and method for processing prescription medications. However, as discussed above, Applicants note that since the filing date of East is November 24, 1997, East is not statutory prior art for the claimed invention, and is therefore inapposite with regard to the rejection of the claims in the instant application.

Independent claim 1 recites a combination of features directed to an automatic prescription filling and dispensing system. As recited by claim 1, the system comprises, inter alia, “pill dispensing machines to automatically count out and dispense pills into prescription bottles in accordance with prescription orders.” The system also comprises “means to print literature packs customized to said prescription orders.” In addition, the system comprises an “order consolidation means to present a shipping container for each order, to insert the prescription bottle for said order into such shipping container and to insert, separately from any prescription bottle inserted into the shipping container, the literature pack for said order into such shipping container.” This combination of features of independent claim 1, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of elements recited above. Without conceding that Goldberg or East discloses or suggests any of the elements recited in claim 1, both references absolutely fail to teach or suggest, in addition, at

least the feature of any form of literature pack, being inserted separately from a bottle for a prescription order. In fact, neither reference discloses *anything* with regard to a literature pack being associated with a bottle of a prescription order. Other features are also clearly absent from a cursory inspection of Goldberg and East.

With respect to the rejected dependent claims 2-3, the Examiner's position is insufficient to show that the rejected dependent claims are not patentable over the prior art of record.

Applicants respectfully submit that dependent claims 2-3 are not only allowable by virtue of their dependency from independent claim 1, but also because of additional features they recite. Claim 2, for example, recites, inter alia, additional details pertaining to the literature pack. In view of the above, the Examiner's position is insufficient to show that rejected dependent claims 2-3 are not patentable over the prior art (assuming *arguendo* that East is prior art).

In view of the above, Applicants submit that the combination of features recited in each of claims 1-3 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when each respective claim is interpreted as a whole.

B. Claims 4, 6 and 7

Independent claim 4 recites a combination of features directed to a prescription dispensing and packing system. As recited by claim 4, the system comprises, inter alia, "a plurality of bottle carriers each having receptacles to receive a plurality of pill bottles." The system also comprises "means to receive orders for prescriptions," and "means to load prescription bottles corresponding to the prescriptions of said orders into scheduled locations in said carriers." In addition, the system comprises "a prescription pill dispensing machine," and "means to transport said carriers with said prescription bottles through said dispensing machine, said dispensing machine dispensing the pills of said orders into the bottles in said carriers in accordance with the scheduled locations of the pill bottles in said carriers." The system further comprises "order consolidation means receiving carriers from said dispensing machine and presenting shipping containers to be filled, each shipping container corresponding to an order, said order consolidation means unloading bottles from said carriers and loading bottles into shipping containers corresponding to the orders, said order consolidation means determining each bottle to go in each shipping container from the scheduled location of such bottle in a carrier."

This combination of features of independent claim 4, when interpreted as a whole, is submitted to patentably distinguish over the prior art. Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of elements recited above. Without conceding that Goldberg or East discloses or suggests any of the elements recited in claim 4, both references absolutely fail to teach or suggest, in addition, at least the feature of an order consolidation means that unloads bottles from carriers and loads the bottles into shipping containers corresponding to the orders. It also follows, therefore, that both references absolutely fail to teach or suggest an order consolidation means that determines that each bottle goes in a shipping container based on the scheduled location of such bottle in the carrier. Other features are also clearly absent from a cursory inspection of Goldberg and East.

Further, the Examiner states (with regard to all claims) that “[i]t is well known in the art to use carriers to transport bottles.” Applicants respectfully submit that it is not well known in the art to utilize “a plurality of bottle carriers each having receptacles to receive a plurality of pill bottles” in combination with the remaining features of the claim when claim 4 is interpreted as a whole. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to carriers pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2) detailing why it would have been obvious. In the absence of either, Applicants respectfully request withdrawal of the rejection.

With respect to the rejected dependent claims 5-7, the Examiner’s position is insufficient to show that the rejected dependent claims are not patentable over the prior art of record. Applicants respectfully submit that dependent claims 5-7 are not only allowable by virtue of their dependency from independent claim 4, but also because of additional features they recite. Claim 6, for example, recites, inter alia, “conveying means organizing said carries into ranks of a plurality of carriers.” In view of the above, the Examiner’s position is insufficient to show that rejected dependent claims 5-7 are not patentable over the prior art (assuming *arguendo* that East is prior art).

C. Claims 8 and 9

Independent claim 8 recites a combination of features directed to a system for assembling prescription orders. As recited by claim 8, the system comprises, inter alia, “a multiplicity of carriers each having the capability of receiving a multiplicity of prescription bottles in scheduled locations.” The system also comprises “means to assemble a plurality of carriers at said order and packing station, and packing means at said order and consolidation station to remove the prescription bottles of said order from the scheduled locations in the carriers of said plurality and pack the bottles of said order in a container.”

This combination of features of independent claim 8, when interpreted as a whole, is submitted to patentably distinguish over the prior art. Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of elements recited above. Without conceding that Goldberg or East discloses or suggests any of the elements recited in claim 8, both references absolutely fail to teach or suggest, in addition, at least the feature of means to assemble a plurality of carriers at an order and packing station. Other features are also clearly absent from a cursory inspection of Goldberg and East.

Further, the Examiner states (with regard to all claims) that “[i]t is well known in the art to use carriers to transport bottles.” Applicants respectfully submit that it is not well known in the art to utilize “a multiplicity of carriers each having the capability of receiving a multiplicity of prescription bottles in scheduled locations” in combination with the remaining features of the claim when claim 8 is interpreted as a whole. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to carriers pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2) detailing why it would have been obvious. In the absence of either, Applicants respectfully request withdrawal of the rejection.

With respect to the rejected dependent claim 9, the Examiner’s position is insufficient to show that rejected claim 9 is not patentable over the prior art of record. Applicants respectfully submit that dependent claim 9 is not only allowable by virtue of its dependency from independent claim 8, but also because of additional features it recites. Claim 9 recites, inter alia, “means to print literature for said order.” In view of the above, the Examiner’s position is

insufficient to show that claim 9 is not patentable over the prior art (assuming *arguendo* that East is prior art).

D. Claims 10 and 11

Independent claim 10 recites a combination of features directed to a system for sorting prescriptions by prescription order. As recited by claim 10, the system comprises, inter alia, “a carrier having the capability of receiving a multiplicity of prescription bottles in assigned locations.” The system also comprises “means responsive to a prescription of an order to provide a prescription bottle filled with pharmaceuticals in accordance with said prescription in an assigned location in said carrier.” Finally, the system comprises “an order consolidation and packing station comprising means to receive said carrier and remove said prescription bottle from said assigned location in said carrier and pack said prescription bottle in a container corresponding to said order.”

This combination of features of independent claim 10, when interpreted as a whole, is submitted to patentably distinguish over the prior art. Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of elements recited above. Without conceding that Goldberg or East discloses or suggests any of the elements recited in claim 10, both references absolutely fail to teach or suggest at least the feature of means to receive a carrier and remove a prescription bottle from an assigned location in the carrier and pack the prescription bottle in a container corresponding to the order. Other features are also clearly absent from a cursory inspection of Goldberg and East.

Further, the Examiner states (with regard to all claims) that “[i]t is well known in the art to use carriers to transport bottles.” Applicants respectfully submit that it is not well known in the art to utilize “a carrier having the capability of receiving a multiplicity of prescription bottles in assigned locations” in combination with the remaining features of the claim when claim 10 is interpreted as a whole. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to carriers pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2) detailing why it would have been obvious. In the absence of either, Applicants respectfully request withdrawal of the rejection.

With respect to the rejected dependent claim 11, the Examiner's position is insufficient to show that the rejected claim 11 is not patentable over the prior art of record. Applicants respectfully submit that dependent claim 11 is not only allowable by virtue of its dependency from independent claim 10, but also because of additional features it recites. Claim 11 recites, inter alia, "means to print literature corresponding to said order." In view of the above, the Examiner's position is insufficient to show that claim 11 is not patentable over the prior art (assuming *arguendo* that East is prior art).

E. Claims 12-15

Independent claim 12 recites a combination of features directed to method of sorting prescription bottles by prescription order. As recited by claim 12, the method comprises the step of, inter alia, "placing the prescription bottles of each order in scheduled locations in carriers, each carrier having a multiplicity of locations to receive prescription bottles." The method also comprises the step of "removing the prescription bottles from the scheduled locations in said carriers in accordance with said record and placing the prescription bottles of each order in a separate container." In addition, the method comprises the steps of "identifying prescription bottles corresponding to each order," and "maintaining a record for each order of the identification of the carriers containing the prescription bottles of each order and the scheduled location in said carriers of each prescription bottle of each order." This combination of features of independent claim 12, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of steps recited above. Without conceding that Goldberg or East discloses or suggests any of the steps recited in claim 12, both references absolutely fail to teach or suggest at least the step of maintaining a record for each order of the identification of the carriers containing the prescription bottles of each order and the scheduled location in the carriers of each prescription bottle of each order. In fact, neither reference discloses *anything* with regard carriers containing prescription bottles. Other features are also clearly absent from a cursory inspection of Goldberg and East.

Further, the Examiner states (with regard to all claims) that “[i]t is well known in the art to use carriers to transport bottles.” Applicants respectfully submit that it is not well known in the art to utilize the step of “placing the prescription bottles of each order in scheduled locations in carriers, each carrier having a multiplicity of locations to receive prescription bottles” in combination with the remaining features of the claim when claim 12 is interpreted as a whole. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to carriers pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2) detailing why it would have been obvious. In the absence of either, Applicants respectfully request withdrawal of the rejection.

With respect to the rejected dependent claims 13-15, the Examiner’s position is insufficient to show that the rejected dependent claims are not patentable over the prior art of record. Applicants respectfully submit that dependent claims 13-15 are not only allowable by virtue of their dependency from independent claim 12, but also because of additional features they recite. Claims 14 and 15 recite, inter alia, additional details pertaining to the timing of the prescription bottles being filled with pills, which are not taught or suggested by the prior art cited by the Examiner (assuming *arguendo* that East is prior art).

In view of the above, Applicants submit that the combination of features recited in each of claims 12-15 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when each respective claim is interpreted as a whole.

F. Independent Claim 16

Independent claim 16 recites a combination of features directed to an automatic prescription filling and dispensing system. As recited by claim 16, the system comprises, inter alia, “at least one order consolidation and packing (OCP) station.” The OCP station “presents a shipping container for each prescription order,” and “inserts at least one bottle for each prescription order into the shipping container and inserts, separately from the at least one bottle inserted into the shipping container a corresponding literature pack for each prescription order into the shipping container corresponding to the prescription order.” This combination of features of independent claim 16, when interpreted as a whole and in combination with the other limitations recited in claim 16, is submitted to patentably distinguish over the prior art.

Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of elements recited above. Without conceding that Goldberg or East discloses or suggests any of the elements recited in claim 16, both references absolutely fail to teach or suggest, in addition, at least the feature of any form of literature pack, being inserted separately from a bottle for a prescription order. In fact, neither reference discloses *anything* with regard to a literature pack being associated with a bottle of a prescription order. Other features are also clearly absent from a cursory inspection of Goldberg and East.

In view of the above, Applicants submit that the combination of features recited in claim 16 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when claim 16 is interpreted as a whole.

G. Claims 30, 31 and 36-43

The Examiner states (with regard to all claims) that “[i]t is well known in the art to use carriers to transport bottles.” Applicants respectfully submit that it is not well known in the art to utilize “a plurality of carriers, each having receptacles to receive a plurality of bottles in schedules locations” in combination with the remaining features of the claim when claim 30 is interpreted as a whole. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to carriers pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2) detailing why it would have been obvious. In the absence of either, Applicants respectfully request withdrawal of the rejection.

Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of elements recited in claim 30. Without conceding that Goldberg or East discloses or suggests any of the elements recited in claim 30, both references absolutely fail to teach or suggest, in addition, at least the feature of “loading at least one of the plurality of bottles into at least one shipping container corresponding to at least one of the prescription orders” in combination with other claimed limitations. Goldberg, as previously noted, merely transmits packages corresponding to an order along a lane corresponding to the order. Goldberg does not dispose of any items in a shipping container, let alone a shipping container corresponding to a prescription

order. East uses the term “package” in the sense of applying, for example, a translucent cover to a medication disk 68 (col. 7:60 – col. 8:6). Applicants find no disclosure in East regarding placing a medication disk 68 (or other prescription container) into a shipping container as recited in the claimed invention. Other features are also clearly absent from a cursory inspection of Goldberg and East. Accordingly, and for at least these reasons, the Examiner’s position is insufficient to show that rejected claim 30 is not patentable over the prior art.

With regard to dependent claim 31, Applicants believe that the prior art of record does not teach or suggest inserting “into the shipping container corresponding to the at least one of the prescription orders a literature pack corresponding to the at least one of the prescription orders” in combination with other claimed limitations as discussed with regard to claim 30. It is therefore respectfully submitted that dependent claim 31 is allowable over the art of record.

With respect to the rejected dependent claims 36-43, the Examiner’s position is insufficient to show that the rejected dependent claims are not patentable over the prior art of record. Applicants respectfully submit that dependent claims 36-43 are not only allowable by virtue of their dependency from independent claim 30, but also because of additional features they recite. Claim 38, for example, recites a literature pack which, as previously discussed, is neither taught nor suggested by either Goldberg or East. Claim 40 recites that the transport devices organize the bottle carriers into “ranks of carriers.” Applicants find nothing in either reference with regard to a dispensing machine receiving “ranks of carriers,” particularly when taken in combination with the limitations recited in claim 30. Claim 38 and 41 recite additional details with regard to the shipping container. Applicants find nothing in either reference that teaches or suggests the features of the claimed invention recited in claims 38 and 41.

Further, with regard to claim 43, which recites “a radio frequency identification tag,” the Examiner states that “radio tags are well known in the art as they are marketed by Texas Instruments, Inc.” However, the mere fact that radio tags are currently marketed is irrelevant. Further, even if radio tags are well known, that fact alone is irrelevant to the claimed invention of an automatic prescription filling system. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to radio frequency identification tags pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2). In the absence of either, Applicants respectfully request withdraw of the rejection of claim 43.

In view of the above, Applicants submit that the combination of features recited in each of claims 31 and 36-43 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when these claims are interpreted as a whole.

H. Claims 44 and 49-57

As previously noted, the Examiner states (with regard to all claims) that “[i]t is well known in the art to use carriers to transport bottles.” Applicants respectfully submit that, with regard to independent claim 44, it is not well known in the art to utilize “at least one carrier, each having receptacles to receive at least one bottle in scheduled locations” in combination with the remaining features of the claim when claim 44 is interpreted as a whole. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to carriers pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2) detailing why it would have been obvious. In the absence of either, Applicants respectfully request withdrawal of the rejection.

Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of elements recited in claim 44. Without conceding that Goldberg or East discloses or suggests any of the elements recited in claim 44, both references absolutely fail to teach or suggest, in addition, at least the feature of at least one carrier, each having receptacles to receive at least one bottle in scheduled locations. Other features, at least pertaining to the carrier(s), are also clearly absent from a cursory inspection of Goldberg and East.

In addition, neither reference teaches or suggests “at least one order consolidation and packing (OCP) station at which the at least one bottle is unloaded from said at least one carrier and placed in a shipping container corresponding to the at least one prescription order.”

In view of the above, Applicants submit that the combination of features recited in claim 44 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when claim 44 is interpreted as a whole.

With respect to the rejected dependent claims 49-57, the Examiner’s position is insufficient to show that the rejected dependent claims are not patentable over the prior art of record. Applicants respectfully submit that dependent claims 49-57 are not only allowable by virtue of

their dependency from independent claim 44, but also because of additional features they recite. Claims 49 and 52, for example, recite a “literature pack,” which is not taught or suggested by either Goldberg or East. Claims 51 and 55, for example, recite a “shipping container,” which is not taught or suggested by either Goldberg or East. Claim 54, for example, recites “ranks of carriers,” which is not taught or suggested by either Goldberg or East.

Further, with regard to claim 57, which recites “a radio frequency identification tag,” the Examiner states that “radio tags are well known in the art as they are marketed by Texas Instruments, Inc.” However, the mere fact that radio tags are currently marketed is irrelevant. Further, even if radio tags are well known, that fact alone is irrelevant to the claimed invention of an automatic prescription filling system. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to radio frequency identification tags pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2). In the absence of either, Applicants respectfully request withdraw of the rejection of claim 57.

In view of the above, Applicants submit that the combination of features recited in each of claims 49-57 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when these claims are interpreted as a whole.

I. Claims 58, 59 and 65-74

As previously noted, the Examiner states (with regard to all claims) that “[i]t is well known in the art to use carriers to transport bottles.” Applicants respectfully submit that, with regard to independent claim 58, it is not well known in the art to utilize “a plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations” in combination with the remaining features of the claim when claim 58 is interpreted as a whole. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to carriers pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2) detailing why it would have been obvious. In the absence of either, Applicants respectfully request withdrawal of the rejection.

Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of elements recited in claim 58. Without conceding that Goldberg or East discloses or suggests any

of the elements recited in claim 58, both references absolutely fail to teach or suggest, in addition, at least the feature of “at least one order consolidation and packing (OCP) station that receives said plurality of carriers from said at least one dispensing machine and presents shipping containers to be filled.” Also neither reference teaches or suggested anything with regard to literature packs, which is also recited in claim 58. Other features are also clearly absent from a cursory inspection of Goldberg and East.

In view of the above, Applicants submit that the combination of features recited in claim 58 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when claim 58 is interpreted as a whole.

With respect to the rejected dependent claims 59 and 65-74, the Examiner’s position is insufficient to show that the rejected dependent claims are not patentable over the prior art of record. Applicants respectfully submit that dependent claims 59 and 65-74 are not only allowable by virtue of their dependency from independent claim 58, but also because of additional features they recite. Claims 59, 68 and 72, for example, recite a “shipping container,” which is not taught or suggested by either Goldberg or East. Claims 65, 66 and 69, for example, recite a “literature pack,” which is not taught or suggested by either Goldberg or East. Claim 71, for example, recites “ranks of carriers,” which is not taught or suggested by either Goldberg or East.

Further, with regard to claim 74, which recites “a radio frequency identification tag,” the Examiner states that “radio tags are well known in the art as they are marketed by Texas Instruments, Inc.” However, the mere fact that radio tags are currently marketed is irrelevant. Further, even if radio tags are well known, that fact alone is irrelevant to the claimed invention of an automatic prescription filling system. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to radio frequency identification tags pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2). In the absence of either, Applicants respectfully request withdraw of the rejection of claim 74.

In view of the above, Applicants submit that the combination of features recited in each of claims 59 and 65-74 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when these claims are interpreted as a whole.

J. Claims 75, 76 and 81-90

As previously noted, the Examiner states (with regard to all claims) that “[i]t is well known in the art to use carriers to transport bottles.” Applicants respectfully submit that, with regard to independent claim 75, it is not well known in the art to utilize “a plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations” in combination with the remaining features of the claim when claim 75 is interpreted as a whole. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to carriers pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2) detailing why it would have been obvious. In the absence of either, Applicants respectfully request withdrawal of the rejection.

Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of elements recited in claim 75. Without conceding that Goldberg or East discloses or suggests any of the elements recited in claim 75, both references absolutely fail to teach or suggest, in addition, at least the feature of “at least one order consolidation and packing (OCP) station that receives said plurality of carriers from said at least one dispensing machine and presents shipping containers to be filled.” Other features are also clearly absent from a cursory inspection of Goldberg and East.

In view of the above, Applicants submit that the combination of features recited in claim 75 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when claim 75 is interpreted as a whole.

With respect to the rejected dependent claims 76 and 81-90, the Examiner’s position is insufficient to show that the rejected dependent claims are not patentable over the prior art of record. Applicants respectfully submit that dependent claims 76 and 81-90 are not only allowable by virtue of their dependency from independent claim 75, but also because of additional features they recite. Claims 76, 84, 86 and 88, for example, recite additional details pertaining to the shipping container which are not taught or suggested by either Goldberg or East. Claims 81, 82, and 84, for example, recite a “literature pack” and details pertaining thereto, which is not taught or suggested by either Goldberg or East. Claim 87, for example, recites “ranks of carriers,” which is not taught or suggested by either Goldberg or East.

Further, with regard to claim 90, which recites “a radio frequency identification tag,” the Examiner states that radio tags are well known in the art as they are marketed by Texas Instruments, Inc.” However, the mere fact that radio tags are currently marketed is irrelevant. Further, even if radio tags are well known, that fact alone is irrelevant to the claimed invention of an automatic prescription filling system. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to radio frequency identification tags pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2). In the absence of either, Applicants respectfully request withdraw of the rejection of claim 90.

In view of the above, Applicants submit that the combination of features recited in each of claims 76 and 81-90 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when these claims are interpreted as a whole.

K. Claims 91-95

Independent claim 91 recites , inter alia, the step of “printing a literature pack customized to each of the at least one prescription order.” Claim 91 also recites, inter alia, the step of “inserting the literature pack corresponding to each of the at least one prescription order, separate from inserting the at least one bottle corresponding to each of the at least one prescription order into the shipping container corresponding to the at least one prescription order, into the shipping container corresponding to the respective at least one prescription order.”

Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of steps recited in claim 91. Without conceding that Goldberg or East discloses or suggests any of the steps recited in claim 91, both references absolutely fail to teach or suggest at least the two features recited in the preceding paragraph. Other features are also clearly absent from a cursory inspection of Goldberg and East.

In view of the above, Applicants submit that the combination of steps recited in claim 91 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when claim 91 is interpreted as a whole.

With respect to the rejected dependent claims 92-95, the Examiner’s position is insufficient to show that the rejected dependent claims are not patentable over the prior art of record.

Applicants respectfully submit that dependent claims 92-95 are not only allowable by virtue of their dependency from independent claim 91, but also because of additional features they recite. Claim 95, for example, recites additional details pertaining to the shipping container and literature pack, which are not taught or suggested by either Goldberg or East.

In view of the above, Applicants submit that the combination of features recited in each of claims 92-95 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when these claims are interpreted as a whole.

L. Claims 96-103

Independent claim 96 recites, inter alia, the step of “providing a plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations.” Claim 95 also recites, inter alia, the step of “loading at least one of the plurality of bottles and a corresponding literature pack into a shipping container corresponding to each of the at least one prescription order as determined by the scheduled locations of the plurality of bottles.”

The Examiner states (with regard to all claims) that “[i]t is well known in the art to use carriers to transport bottles.” Applicants respectfully submit that it is not well known in the art to utilize “a plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations” in combination with the remaining features of the claim when claim 96 is interpreted as a whole. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to carriers pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2) detailing why it would have been obvious. In the absence of either, Applicants respectfully request withdrawal of the rejection.

Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of steps recited in claim 95. Without conceding that Goldberg or East discloses or suggests any of the steps recited in claim 95, both references absolutely fail to teach or suggest at least the two steps recited in the preceding paragraph. Other features are also clearly absent from a cursory inspection of Goldberg and East.

With respect to the rejected dependent claims 97-103, the Examiner’s position is insufficient to show that the rejected dependent claims are not patentable over the prior art of record.

Applicants respectfully submit that dependent claims 97-103 are not only allowable by virtue of their dependency from independent claim 96, but also because of additional features they recite. Claim 99, for example, recites, inter alia, the step of “organizing the plurality of carriers into ranks of carriers.” Applicants find nothing in either reference with regard to organizing a plurality of carriers into ranks of carriers when taken in combination with the other limitations recited in the claim. Claim 100, for example, recites additional details pertaining to the shipping container and the literature pack, neither of which are taught or suggested by either Goldberg or East.

Further, with regard to claim 103, which recites “a radio frequency identification tag,” the Examiner states that “radio tags are well known in the art as they are marketed by Texas Instruments, Inc.” However, the mere fact that radio tags are currently marketed is irrelevant. Further, even if radio tags are well known, that fact alone is irrelevant to the claimed invention of an automatic prescription filling system. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to radio frequency identification tags pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2). In the absence of either, Applicants respectfully request withdraw of the rejection of claim 103.

In view of the above, Applicants submit that the combination of features recited in each of claims 97-103 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when these claims are interpreted as a whole.

M. Claims 104-109

Independent claim 104 recites, inter alia, the steps of “providing a plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations.” Claim 104 also recites, inter alia, the step of “packing the at least one of the plurality of bottles corresponding to the prescription order in a **shipping container** corresponding to the prescription order.”

The Examiner states (with regard to all claims) that “[i]t is well known in the art to use carriers to transport bottles.” Applicants respectfully submit that it is not well known in the art to utilize a “plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations” in combination with the remaining features of the claim when claim 104 is interpreted as a whole. The Examiner is respectfully requested to provide a prior art reference to

support the Examiner's position with regard to carriers pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2) detailing why it would have been obvious. In the absence of either, Applicants respectfully request withdrawal of the rejection.

Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of steps recited in claim 104. Without conceding that Goldberg or East discloses or suggests any of the steps recited in claim 104, both references absolutely fail to teach or suggest at least the two steps recited in the preceding paragraph, particularly when taken in combination with other limitations recited in the claim. Other features are also clearly absent from a cursory inspection of Goldberg and East.

With respect to the rejected dependent claims 105-109, the Examiner's position is insufficient to show that the rejected dependent claims are not patentable over the prior art of record. Applicants respectfully submit that dependent claims 105-109 are not only allowable by virtue of their dependency from independent claim 104, but also because of additional features they recite. Claims 105 and 106, for example, recite steps pertaining to "printing a literature pack." Applicants find nothing in either reference with regard to a literature pack.

Further, with regard to claim 109, which recites "a radio frequency identification tag," the Examiner states that "radio tags are well known in the art as they are marketed by Texas Instruments, Inc." However, the mere fact that radio tags are currently marketed is irrelevant. Further, even if radio tags are well known, that fact alone is irrelevant to the claimed invention of an automatic prescription filling system. The Examiner is respectfully requested to provide a prior art reference to support the Examiner's position with regard to radio frequency identification tags pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2). In the absence of either, Applicants respectfully request withdraw of the rejection of claim 109.

In view of the above, Applicants submit that the combination of features recited in each of claims 105-109 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when these claims are interpreted as a whole.

N. Claims 110-113

Independent claim 110 recites, inter alia, the step of “comprising the steps of “receiving a plurality of bottles, each having an assigned location in a bottle carrier corresponding to a prescription order comprising at least one prescription.” Claim 110 also recites the step of “packing at least one of the plurality of bottles in a shipping container corresponding to the prescription order.”

The Examiner states (with regard to all claims) that “[i]t is well known in the art to use carriers to transport bottles.” Applicants respectfully submit that it is not well known in the art to utilize a “a plurality of bottles, each having an assigned location in a bottle carrier corresponding to a prescription order comprising at least one prescription” in combination with the remaining features of the claim when claim 110 is interpreted as a whole. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to carriers pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2) detailing why it would have been obvious. In the absence of either, Applicants respectfully request withdrawal of the rejection.

Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of steps recited in claim 110. Without conceding that Goldberg or East discloses or suggests any of the steps recited in claim 110, both references absolutely fail to teach or suggest at least the two steps recited in the preceding paragraph, particularly when taken in combination with other limitations recited in the claim. Other features are also clearly absent from a cursory inspection of Goldberg and East.

With respect to the rejected dependent claims 111-113, the Examiner’s position is insufficient to show that the rejected dependent claims are not patentable over the prior art of record. Applicants respectfully submit that dependent claims 111-113 are not only allowable by virtue of their dependency from independent claim 110, but also because of additional features they recite. Claims 111 and 112, for example, recite steps pertaining to “printing a literature pack.” Applicants find nothing in either reference with regard to a literature pack. Further, claim 112 also recites additional details pertaining to the shipping container.

In view of the above, Applicants submit that the combination of features recited in each of claims 111-113 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when these claims are interpreted as a whole.

O. Claims 114-115 and 121-123

Independent claim 114 recites, inter alia, “a plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations.” Claim 114 also recites “at least one dispensing machine responsive to said computer that automatically counts and dispenses the type and quantity of pharmaceuticals into the plurality of bottles in accordance with the prescription orders in the scheduled locations of the corresponding plurality of carriers.”

The Examiner states (with regard to all claims) that “[i]t is well known in the art to use carriers to transport bottles.” Applicants respectfully submit that it is not well known in the art to utilize a “plurality of carriers each having receptacles to receive a plurality of bottles in scheduled locations” in combination with the remaining features of the claim when claim 114 is interpreted as a whole. The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to carriers pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2) detailing why it would have been obvious. In the absence of either, Applicants respectfully request withdrawal of the rejection.

Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of elements recited in claim 114. Without conceding that Goldberg or East discloses or suggests any of the elements recited in claim 114, both references absolutely fail to teach or suggest at least the two limitations recited in the preceding paragraph, particularly when taken in combination with other limitations recited in the claim. Other features are also clearly absent from a cursory inspection of Goldberg and East.

If the Examiner believes that either reference teaches or suggests anything with regard to scheduled locations of a plurality of carriers having receptacles, he is requested to specifically indicate where, by column and line number, in such reference that the disclosure occurs. Accordingly, and for at least these reasons, the Examiner’s position is insufficient to show that rejected claim 114 is not patentable over the prior art (assuming *arguendo* that East is prior art).

With respect to the rejected dependent claims 115 and 121-123, the Examiner's position is insufficient to show that the rejected dependent claims are not patentable over the prior art of record. Applicants respectfully submit that dependent claims 115 and 121-123 are not only allowable by virtue of their dependency from independent claim 114, but also because of additional features they recite. Claim 115, for example, recites that "the plurality of bottles are unloaded from said plurality of carriers and placed in shipping containers corresponding to the prescription orders." Applicants find nothing in either reference with regard to shipping containers.

Further, with regard to claim 123, which recites "a radio frequency identification tag," the Examiner states that "radio tags are well known in the art as they are marketed by Texas Instruments, Inc." However, the mere fact that radio tags are currently marketed is irrelevant. Further, even if radio tags are well known, that fact alone is irrelevant to the claimed invention of an automatic prescription filling system. The Examiner is respectfully requested to provide a prior art reference to support the Examiner's position with regard to radio frequency identification tags pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2). In the absence of either, Applicants respectfully request withdraw of the rejection of claim 123.

In view of the above, Applicants submit that the combination of features recited in each of claims 115 and 121-123 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when these claims are interpreted as a whole.

P. Claims 124-129

Independent claim 124 recites, inter alia, the step of "in a single run, dispensing into bottles different quantities of different pharmaceuticals in accordance with at least one prescription order comprising at least one prescription."

Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of steps recited in claim 124. Without conceding that Goldberg or East discloses or suggests any of the steps recited in claim 124, both references absolutely fail to teach or suggest at least the limitation recited in the preceding paragraph, particularly when taken in combination with other

limitations recited in the claim. Other features are also clearly absent from a cursory inspection of Goldberg and East.

Specifically, Applicants believe that the prior art of record does not teach or suggest anything with regard to dispensing different quantities of different pharmaceuticals in a single run. Goldberg, of course, has nothing to do with dispensing pharmaceuticals. In addition, East does not teach or suggest dispensing different quantities of different pharmaceuticals in a single run. East's dispensing operation is disclosed at column 7, lines 8-63. Nothing in East teaches or suggests that different quantities of different pharmaceuticals are dispensed in a single run. In fact, East suggests the opposite (at column 7, lines 60-61) in that each "medication disk 68 is filled with pills," while only disclosing a single size medication disk (see, e.g., Figures 5, 9 and 11). Accordingly, and for at least these reasons, the Examiner's position is insufficient to show that rejected claim 124 is not patentable over the prior art (assuming *arguendo* that East is prior art).

With respect to the rejected dependent claims 125-129, the Examiner's position is insufficient to show that the rejected dependent claims are not patentable over the prior art of record. Applicants respectfully submit that dependent claims 125-129 are not only allowable by virtue of their dependency from independent claim 124, but also because of additional features they recite. Claim 126, for example, recites the step of "placing in a shipping container at least one bottle corresponding to a prescription order." Applicants find nothing in either reference with regard to shipping containers. Further, claims 127 and 128 recite a "literature pack" and features pertaining thereto. Applicants find nothing in either reference with regard to literature packs.

In view of the above, Applicants submit that the combination of features recited in each of claims 125-129 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when these claims are interpreted as a whole.

Q. Claims 130-134

Independent claim 130 recites, inter alia, the step of "dispensing into bottles, in a single run, different quantities of different pharmaceuticals in accordance with prescription orders comprising at least one prescription."

Even assuming *arguendo* that East is prior art or that the Examiner is able to find another reference similar to East, neither reference teaches or suggests at least the combination of steps recited in claim 130. Without conceding that Goldberg or East discloses or suggests any of the steps recited in claim 130, both references absolutely fail to teach or suggest at least the limitation recited in the preceding paragraph. More specifically, as noted above (with regard to claims 124-129), the prior art of record does not teach or suggest anything with regard to dispensing different quantities of different pharmaceuticals in a single run, particularly when taken in combination with the other limitations recited in the claim. Accordingly, and for at least this reason, the Examiner's position is insufficient to show that rejected claim 130 is not patentable over the prior art (assuming *arguendo* that East is prior art). Other features are also clearly absent from a cursory inspection of Goldberg and East.

With respect to the rejected dependent claims 131-134, the Examiner's position is insufficient to show that the rejected dependent claims are not patentable over the prior art of record. Applicants respectfully submit that dependent claims 131-134 are not only allowable by virtue of their dependency from independent claim 130, but also because of additional features they recite. Claim 131 recites that the "bottles are at least two sizes." Applicants find nothing in either reference with regard to dispensing pharmaceuticals, in a single run, in bottles of at least two sizes. As noted above, the medication packs disclosed in East are a single size. Claim 132 recites the step of placing bottle caps on bottles "in accordance with bottle size." Applicants find nothing in either Goldberg or East with respect to bottle size, or associated bottle cap size.

In view of the above, Applicants submit that the combination of features recited in each of claims 131-134 is patentable over the prior art cited by the Examiner (assuming *arguendo* that East is prior art) when these claims are interpreted as a whole.

IV. Conclusion

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, that is patentable. Applicants have emphasized certain features in the claims as clearly not present in the claims, as discussed above. However, Applicants do not concede that other features in the claims are also not missing in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why each of the claims described above are distinguishable over the cited prior art.

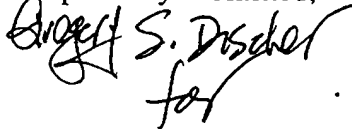
For all the reasons advanced above, Applicants respectfully submit that the rejections must be withdrawn. Consequently, issuance of a Notice of Allowance is respectfully requested.

Authorization

The Commissioner is hereby authorized to charge any additional fees which may be required for this Amendment, or credit any overpayment to deposit account no. 08-0219.

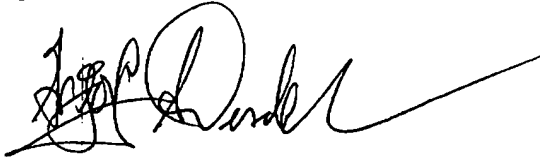
In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to deposit account no. 08-0219.

Respectfully submitted,

for

Irah H. Donner

Registration No. 35,120



Gregory S. Discher

Registration No. 42,488

Date: 02/05/02

HALE and DORR LLP

1455 Pennsylvania Avenue, NW

Washington, DC 20004

(202) 942-8400